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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,198	12/02/1999	PHILLIP D. MOONEY	MOONEY-40-23	9991
7590	04/07/2004		EXAMINER	
			GRANT II, JEROME	
			ART UNIT	PAPER NUMBER
			2626	
DATE MAILED: 04/07/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/452,198	MOONEY ET AL.
	<b>Examiner</b> Jerome Grant II	<b>Art Unit</b> 2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 21 January 2004.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-23 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Detailed Action

1.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter not described in the written specification is, “..an optical character recognizer adapted to recognize and textually convert header information.. modem adapted to automatically transmit said image with said header information based on said textually converted header information.”

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, because the best mode contemplated by the inventor has not been disclosed. Evidence of concealment of the best mode

is based upon a failure in the written specification for converting header information. The written specification, at pages 10 and 12 make reference of customizing a header which is believed to be the designation of the party to whom a document is sent

The amendment filed 1-21-2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: optical reader adapted to convert header information and transmission of textually converted header information.

Applicant is required to cancel the new matter in the reply to this Office Action.

The drawings are objected to because the drawings do not show any headers nor a conversion of headers. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

**2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:**

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5-9, 11-16 and 18-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Baran.

With respect to claim 1, Baran teaches an apparatus for sending an image to a desired destination, comprising:

an optical character recognizer (24) adapted to recognize and textually convert destination information scanned from a predetermined location, (see col. 12, lines 10-15); and a modem (22a-22c) according to col. 6, line 12 adapted to automatically transmit said image based on said textually converted destination information.

With respect to claim 2, see col. 6, lines 50-60.

With respect to claim 5, Baran teaches a scanning an image of embedded characters (via OCR 24 or scanner 32) where the characters are in a document for transmission; converting ( via OCR 3 characters into text data (see figures 2a ad 2b)). Baran teaches sending the document to a unique destination identified by text data (high applicant refers to as header information), see col. 6, lines 50-60.

With respect to claim 6, see display means 162 of figure 8.

With respect to claims 7 and 14, see figure 10 which shows sending and confirmation of signals before data is actually transmitted.

With respect to claims 8 and 15, Baran teaches recognizing the embedded characters using an optical character recognizer 24.

With respect to claims 9 and 16, Baran teaches said embedded characters corresponds to a fax telephone number (58), see figure 2b.

With respect to claims 11 and 18, see figures 2a and 2b of Baran.

With respect to claim 12, Baran teaches sending information to a destination means, comprising: means 24 for scanning (via 32 or 24) an image of embedded characters in document transmission; means 24 for converting said scanned image of embedded characters into textual data; and (modem 2a-22c) as the means for automatically sending said document to a unique destination identified by the text data (which applicant identifies as header information).

With respect to claim 13, Baran teaches display means 162 for displaying text data.

With respect to claim 19, Baran teaches scanning sender information (via scanner 32) from a predetermined portion of a scanned page f a document (top); and including said scanned sender information in a header portion of an outgoing facsimile (see figures 2a and 2g).

With respect to claim 20, Baran teaches said scanned page is a first page of said document. This is inherent in that the coversheet is the first page scanned to designate the fax machine that the entire document is sent to before the entire document is scanned and faxed. See col. 11, line 65 to col. 12, line 15. See also col. 13, lines 1-20.

With respect to claim 21, see figures 2a - 2g.

With respect to claim 22, Baran teaches scanned sender information replaces default sender information. This limitation is inherent with respect to figures 2a-2g. Sender information is placed in the predetermined spaces provided.

With respect to claim 23, Baran teaches means (scanner 32 or OCR 24) for scanning sender information from a predetermined portion of a scanned page f a document; and means (24) including said scanned sensor information (see figures 2a-2b) in a header portion of an outgoing facsimile.

**3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary

skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran in view of Nakamura.

Baran teaches all of the subject matter upon which the claim depends except for the scanner including a white board.

Nakamura clearly shows using a white board for a scanner, (see col. 5, lines 30-35).

It would have been obvious to one of ordinary skill in the art to modify scanner 32 of Baran so that it uses a white board on the platen for calibrating the charge coupled device prior to performing a scanning operation as taught by Nakamura (see col. 5, lines 30-35).

**4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baran in view of Nakamura as applied to claim 3 above, and further in view of Eguchi.**

Baran and Nakamura teaches all of the subject matter upon which the claim depends, except for a wireless link between the scanner and the fax modem.

Eguchi teaches a wireless link between a scanner 2 of a first device and a fax modem 10 of a second device using the same circuitry as shown by figure 1.

Although Baran and Nakamura have not addressed the wireless communication feature, such a limitation would have been made obvious in view of the teachings of Eguchi. Hence, it would have been obvious to one of ordinary skill in the art to modify modem 36 of Baran or modify the communication means 64 of Nakamura by attaching a wireless modem instead of a wired modem so that a scanner has a wireless hookup to the fax mode, as suggested by Eguchi.

**5. Claims 10 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baran in view of Eguchi.**

Baran teaches all of the subject matter except for embedded data is E-mail information. Eguchi teaches character data embedded in a document corresponding to an E-mail address. See figure 2 of Eguchi.

Since, Baran and Eguchi are both directed to the art of image scanning and transmission, the purpose of embedding characters in a document for use in an E-mail would have been recognized by Baran as suggested by Eguchi.

It would have been obvious to one of ordinary skill in the art to modify communication means 64 of Baran so that it not only reads fax or telephone numbers but also embedded characters and generate E-mail messages from the embedded characters, as suggested by Eguchi.

6.

Examiner's Remarks

The examiner has considered applicants remarks with respect to claims 1-4 but are unpersuasive for the reasons presented regarding the 112 rejections.

Applicant attempts to argue that Baran is not directed toward a header. Baran does provide a header as text information located on the document for the purpose of designating where the transmitted document is to be sent. Applicant provides no working definition other than a standard commonly known to one of ordinary skill in the art, namely alphanumeric data at the top portion of a document.

The argument to claim 3 is unpersuasive for all the reasons set forth above.

The argument to claims 4, 10 and 17 is unpersuasive for reasons of the 112 rejection above.

Moreover, a document with header information is taught by Baran in that the textual information, is used to direct the document to the destination in the header.

Applicant's argument found at the bottom of page 10 is not persuasive for the reasons advanced in the 112 rejections above. There is no teaching in the specification for a conversion of header information.

7.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

**8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.**

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly Williams, can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-3900.

J. Grant II   
JEROME GRANT II  
PRIMARY EXAMINER